Appl. No. 10/748,759
Amdt. dated October 1, 2008
Reply to Office Action of July 1, 2008

PATENT

## REMARKS/ARGUMENTS

This Amendment is in response to the Office Action mailed July 1, 2008. Claims 1, 2, 4, and 6-21 were pending in the present application. This Amendment amends claims 1, 4, 9, and 16; cancels claim 15; and adds new claim 35, leaving pending in the application claims 1, 2, 4, 6-14, 16-21, and 35. Claims 1, 2, 4, and 6-8 are rejected as allegedly being rendered obvious by *Calabria* (US 2005/0137939) in view of *Bronnimann* (US 2004/0044571). Claims 9-21 are rejected as allegedly being rendered obvious by *Bronnimann* in view of *Calabria*. In view of the following remarks, reconsideration of the rejected claims and consideration of the newly presented claim are respectfully requested.


**I.     Claims 1, 2, 4, and 6-21 Are Not Rendered Obvious by *Calabria* and *Bronnimann***

Claims 1, 2, 4, and 6-21 are each rejected under 35 U.S.C. §103(a) as allegedly being obvious over some combination of *Calabria* and *Bronnimann*.

With regard to rejections under 35 U.S.C. § 103, the Examiner must provide evidence which as a whole shows that the legal determination sought to be proved (*i.e.*, the reference teachings establish a *prima facie* case of obviousness) is more probable than not." MPEP §2142. Accordingly, "the key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious." MPEP §2142; see *KSR International Co. v. Teleflex, Inc.*, 550 U.S.__, 82 USPQ 2d 1385 (1395-97 (2007).


### Independent Claim 1

Applicants' claim 1 as amended recites a computer system for requesting advertisements to be placed along with content on behalf of an advertiser in association with a keyword, comprising:

> a plurality of advertisement generators that each use a different algorithm to automatically generate at least one advertisement to be included in an advertisement set for the advertiser and the keyword, each algorithm specifying at least one creative aspect of a respective advertisement

generated for the advertiser and the keyword, each generated advertisement set having at least one
different advertisement;
a fee calculator that calculates fee amounts for each of the advertisement sets generated by
the advertisement generators based on anticipated profitability of the advertisement sets;
an advertisement manager that:
receives from the advertisement generators the generated advertisement sets,
receives from the fee calculator a fee amount for each of the generated
advertisement sets,
determines whether an advertisement set is currently submitted to an
advertisement placement service for the keyword, and
when an advertisement set is not currently submitted to the advertisement
placement service for the keyword, selects one of the generated advertisement sets for
submission to the advertisement placement service; and
an advertisement submitter that, when an advertisement set is not currently submitted to
the advertisement placement service for the keyword:
receives from the advertisement manager the selected advertisement set and the
fee amount for the selected advertisement set, and
sends to the advertisement placement service a request to place the selected
advertisement set along with content associated with the keyword at the fee amount of the
selected advertisement set.

Such limitations are neither taught nor suggested by these references.

For example, *Calabria* teaches a "server-based method of automatically generating

a plurality of bids for an advertiser for placement of at least one advertisement in

associated with a search results list" (paragraph [0021]). *Calabria* teaches "_receiving_ at

least one candidate advertisement from the advertiser" then "creating a list of candidate

keywords" and "calculating a bid amount for each advertisement-keyword pair" (paragraph

[0021]). *Calabria* teaches "an advertisement selection agent (54)" that "includes an

algorithm for _selection_ of an advertisement from the advertisement database (46) that is to

be matched with a given keyword of keyword combination" (paragraphs [0052] and

[0121]). *Calabria* uses "a bidding agent (50)" to "_select_ a corresponding keyword

advertisement" and determine a bid to be submitted (paragraph [0042]).

*Calabria* does not, however, teach or suggest "a plurality of advertisement

generators" as recited in Applicants' claim 1 as amended, where each advertisement

generator uses "a different algorithm to automatically _generate_ at least one advertisement

to be included in an advertisement set for the advertiser and the keyword, _each algorithm_

_specifying at least one creative aspect of a respective advertisement generated for the_

_advertiser and the keyword_". Applicants' claim 1 also recites " an advertisement manager"

Appl. No. 10/748,759
Amdt. dated October 1, 2008
Reply to Office Action of July 1, 2008

PATENT

that "receives from the advertisement generators the generated advertisement sets" and receives "a fee amount for each of the generated advertisement sets", and "selects one of the generated advertisement sets for submission". As discussed, *Calabria* instead teaches only selecting an existing ad, matching candidate keywords with the selected ad, and determining a bid price for the combination. *Calabria* thus does not teach or suggest " a plurality of advertisement generators" as recited in Applicants' claim 1.

 *Bronnimann* does not make up for the deficiencies in *Calabria* with respect to Applicants' claim 1. *Bronnimann* teaches approaches for "varying provided advertisements to increase effectiveness and revenues derived from the advertisements" (paragraph [0002]). *Bronnimann* teaches that "an individual advertiser may be permitted to supply multiple advertisements corresponding to a single keyword bid within a pay-for-placement search engine" paragraph [0009]). In such a system, advertisement providers "connect over a network (14) to an Advertisement Listings Provider (16)" to "register, provide payment information, bids, and associated advertisements (also called creatives) associated with the bid" (paragraph [0041]). *Bronnimann* then determines a "listing of advertisements from the database based on criteria provided and depending on the forum for the advertisements" and can determine an "order to the listing" based on factors such as "revenue efficiency", and can submit the ordered advertisements to an advertiser using an "advertiser communication module (38)" (paragraph [0044]).

 As can be seen, *Bronnimann* also does not teach or suggest "a plurality of advertisement generators" as recited in Applicants' claim 1 as amended, where each advertisement generator uses "a different algorithm to automatically generate at least one advertisement to be included in an advertisement set for the advertiser and the keyword, each algorithm specifying at least one creative aspect of a respective advertisement generated for the advertiser and the keyword". As discussed, *Bronnimann* instead teaches only selecting ads submitted by an advertiser, and processing those submitted ads. *Bronnimann* thus does not teach or suggest "a plurality of advertisement generators" as recited in Applicants' claim 1.

Appl. No. 10/748,759
Amdt. dated October 1, 2008
Reply to Office Action of July 1, 2008

PATENT

Thus, even if for sake of argument there were some motivation to combine *Calabria* and *Bronnimann*, the combination still would not render obvious Applicants' claim 1, as the combination still would process only existing or submitted ads, and would not teach or suggest "a plurality of advertisement generators" each using "a different algorithm to automatically <u>generate</u> at least one advertisement to be included in an advertisement set" that specifies "at least one creative aspect of a respective advertisement generated for the advertiser and the keyword". As such, Applicants' claim 1 cannot be rendered obvious by these references. Applicants thus respectfully request that the rejections with respect to claim 1 be withdrawn.

### Claims 2, 4, and 6-8

Claims 2, 4, and 6-8 are allowable over the cited references in view of their dependency from claim 1. Further, elements of at least some of these claims are also patentable over these references as these elements also are neither taught nor suggested by these references. For example, claim 6 recites "multiple advertisement submitters where each advertisement submitter is associated with an advertisement placement service" and claim 7 recites "a database containing statistics relating to placements of advertisements and wherein the fee calculator determines anticipated profitability based on analysis of the statistics", which are neither taught nor suggested by these references. For at least these reasons, claims such as claims 6 and 7 are allowable in their own right. Applicants therefore respectfully request that the rejections with respect to claims 2, 4, and 6-8 be withdrawn.

### Independent Claim 9

Applicants' claim 9 as amended recites, in part, a "method in a computer system for placing advertisements, the method comprising:

> automatically generating at least one advertisement for each of a plurality of advertisement sets using a different algorithm for each advertisement set, each algorithm specifying at least one creative aspect of the at least one advertisement generated by that algorithm, each advertisement set being generated for the same advertiser and the same keyword and specifying at least one automatically generated advertisement, the keyword, and a bid amount".

For reasons including at least some of those discussed above, neither *Calabria* nor *Bronnimann*, individually or in combination, teach or suggest "automatically generating at least one advertisement for each of a plurality of advertisement sets using a different algorithm for each advertisement set, each algorithm specifying at least one creative aspect of the at least one advertisement generated by that algorithm" as recited in Applicants' claim 9. As such, Applicants' claim 9 cannot be rendered obvious by these references. Applicants thus respectfully request that the rejections with respect to claim 9 be withdrawn.

### Claims 10-21

Claims 10-21 are allowable over the cited references in view of their dependency from claim 9. Further, elements of at least some of these claims are also patentable over these references as these elements also are neither taught nor suggested by these references. For example, claim 13 recites "calculating the bid amount based on advertising metrics", and claim 14 recites "wherein the bid amount is adjusted based on advertising metrics." Further, claim 16 recites "wherein the advertisement set is selected based on effectiveness of the advertisement generator that generated the advertisement sets", claim 20 recites "filtering the generated advertisement sets based on frequency of keywords", and claim 21 recites "filtering the generated advertisement sets based on desirability of keywords". Such elements are neither taught nor suggested by these references. For at least these reasons, claims such as claims 13, 14, 16, 20, and 21 are allowable in their own right.

Further, it is respectfully submitted that elements such as "filtering the generated advertisement sets based on frequency of keywords" and "filtering the generated advertisement sets based on desirability of keywords" as recited in claims 20 and 21, particularly in light of the elements of the respective independent claim, are not rendered obvious by that which is old and well known in the art. Applicants thus respectfully object to the Official Notice. Even if for sake of argument "determining search terms" can

Appl. No. 10/748,759
Amdt. dated October 1, 2008
Reply to Office Action of July 1, 2008

PATENT

depend upon aspects such as frequency or desirability, it is respectfully submitted that it is not known in the art to "filter generated advertising sets" as recited in these claims, and such elements would not be rendered obvious by processes for determining search terms as alleged in the Office Action.

Applicants therefore respectfully request that the rejections with respect to claims 10-21 be withdrawn.

## II.    Amendment to the Claims

Unless otherwise specified or addressed in the remarks section, amendments to the claims are made for purposes of clarity, and are not intended to alter the scope of the claims or limit any equivalents thereof. The amendments are supported by the specification and do not add new matter.   In addition, by focusing on specific claims and claim elements in the discussion above, applicants do not imply that other claim elements are disclosed or suggested by the references.  In addition, any characterizations of claims and/or cited art are being made to facilitate expeditious prosecution of this application. Applicants reserve the right to pursue at a later date any other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by another prosecution.  Accordingly, reviewers of this or any child or related prosecution history shall not reasonably infer that applicants have made any disclaimers or disavowals of any subject matter supported by the present disclosure.
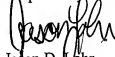
## III.    Newly Presented Claims

Claim 35 has been added to cover different aspects of the present invention.  In particular, claim 35 was added to claim a computer program product including program code for performing steps including subject matter similar to that recited in other pending claims.  The claim is thus supported by similar portions of the specification and does not add new matter.  Applicants therefore respectfully request consideration of newly presented claim 35.

Appl. No. 10/748,759
Amdt. dated October 1, 2008
Reply to Office Action of July 1, 2008

PATENT

## CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 925-472-5000.

Respectfully submitted,

Jason D. Lohr
Reg. No. 48,163

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 925-472-5000
Fax: 415-576-0300
JDL:slh
61513330 v1